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In re Application of
Leopold HACKL
Application No.: 09/762,143
PCT No.: PCT/IB99/01516
Int. Filing Date: 02 August 1999
Priority Date: 31 July 1998
Attorney's Docket No.: WLH-7945
For: METHOD AND INSTALLATION OF
PYROLYSIS OF WASTE PRODUCTS CONTAINING
HYDROCARBONS

DECISION ON

37 CFR 1.42 PAPERS

This is a decision on the papers filed on 31 January 2001, which is being treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 02 August 1999, applicants filed international application PCT/IB99/01516, which claimed priority of an earlier German application filed 31 July 1998. A Demand for international preliminary examination was filed on 29 February 2000 and accordingly, the thirty month period for paying the basic national fee for processing in the United States expired at midnight on 29 February 2001.

On 06 March 2000, the International Bureau mailed a Notification of the Recording of a Change (Form PCT/IB/306) to applicants indicating that sole applicant/inventor Leopold Hackl is recorded as a deceased inventor and that Eva Maria Hackl should be recorded as heiress of the deceased inventor.

On 31 January 2001, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter were, *inter alia*: the basic national fee and a declaration executed by "Eva Maria Hackl, heir to Leopold Hackl".

On 14 March 2001, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) indicating that an English translation of the international application and a processing fee for filing the translation after the thirty month period was required.

DISCUSSION

The declaration filed on 31 January 2001 indicates that sole inventor Leopold Hackl is deceased. The declaration is signed by Eva Maria Hackl as heir to Leopold Hackl.

Pursuant to 37 CFR 1.42, first sentence:

"In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

The declaration is unacceptable because it fails to indicate that Eva Maria Hackl is the only heir or the legal representative for the deceased inventor (See MPEP §409.01(a)). That is, there may be other heirs who are required to also sign the declaration. The declaration must indicate that Eva Maria Hackl is the sole heir or the legal representative for the deceased to accept the application under 37 CFR 1.42.

Alternatively, applicants' attorney may file a statement certifying that Eva Maria Hackl is the only heir or the legal representative.

It is noted that where a declaration is not clear that it includes the signatures of all the heirs, a statement is required clearly indicating whether or not the estate of the deceased inventor was administered by a legal representative or not. Further, if the estate of the deceased inventor was not represented by a legal representative, all of the heirs should be clearly identified in the declaration. The legal representative of a deceased inventor (or all of the heirs where there was no legal representative) must make the application for patent "on the same terms and conditions applicable to the inventor." 35 U.S.C. 117. The declaration as submitted is defective (see 37 CFR 1.64) since the names of the legal representative(s) of the deceased inventor must be set forth in the declaration or all of the heirs, where there was no legal representative. The legal representatives/heirs must identify themselves as the legal representative or heirs of the deceased inventor.

Accordingly, it is inappropriate, at this time, to accord the application status under 37 CFR 1.42.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is presently **DISMISSED WITHOUT PREJUDICE**.

If reconsideration of the merits of the request for status under 37 CFR 1.42 is desired, applicant is required to correct the above-noted defects including the furnishing of an oath/declaration in compliance with 37 CFR 1.42 and 1.497 within TWO (2) MONTHS from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

Any further correspondence with respect to this matter should include a cover letter entitled "Renewed Request Under 37 CFR 1.42" and be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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